

REMARKS/ARGUMENTS

Reconsideration of this application, in view of the foregoing amendment and the following remarks and arguments, is respectfully requested.

Claims 1-44 were originally presented for consideration in this application. By the foregoing amendment, Claims 1 and 18 have been revised. Accordingly, Claims 1-44 remain in this application for consideration and allowance.

In the December 14, 2005 Office Action the Examiner made the following claim rejections which are respectfully traversed for reasons subsequently set forth herein.

1. Claim 38 stands rejected under 35 USC §112, first paragraph, as failing to comply with the enablement requirement;
2. Claims 1-5, 8, 9, 11, 17, 18, 22-24, 29-32, 35-37 and 44 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent 6,470,996 to Kyle et al;
3. Claims 6, 7, 12-16, 25-28, 33, 34 and 43 stand rejected under 35 USC §103(a) as being unpatentable over Kyle et al in view of U.S. Patent 6,470,996 to Tubel;
4. Claims 10, 19-21, 41 and 42 stand rejected under 35 USC §103(a) as being unpatentable over Kyle et al in view of U.S. Patent 6,626,248 to Roberts et al; and
5. Claims 39 and 40 stand rejected under 35 USC §103(a) as being unpatentable over Kyle et al in view of U.S. Patent 4,314,365 to Petersen et al.

The stated basis for the Examiner's 35 USC §112 "lack of enablement" rejection of Claim 38 is, in the Examiner's opinion, that:

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. To be specific, claim 38 claims a subsea well completion having a **test tree structure**....., and the signal cable structure extends externally around the **test tree structure**. Lines 17-26 of page 7 of the specification merely mention "a subsea test tree 34" without any further detail support. Examiner does not clearly understand what the claimed test tree structure is.

The term "subsea test tree" is notoriously well known among those of ordinary skill in the downhole fluid recovery art. Basically, a subsea test tree is a control valving structure adapted to be positioned within a subsea blowout preventer stack for controlling the flow of fluids through a testing string located in an offshore oil well during a production test or the like.

The test for an enabling disclosure is whether one of ordinary skill in the particular art could make and use the claimed invention without undue experimentation. Further, one of ordinary skill in the particular art is presumed to be aware of all of the prior art pertaining to the area of technology under consideration. Thus, where a patent specification sets forth a particular structure or mechanism, such as the subsea test tree structure in this instance, which is well known to one of skill in the particular art, the specification need not re-describe the structure or mechanism in detail, but can merely mention it in passing and still fulfill the enablement requirement of 35 USC §112, first paragraph.

MPEP §2164.03 sets forth the applicable disclosure standard in this instance as follows:

The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art. ... The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification.

In the downhole arts, details of the structure and use of subsea test trees are notoriously well known. Many prior U.S. Patents directed to downhole technology set forth structural and methodology details in the area of subsea test trees (which one of skill in the downhole arts was presumed to know at the time the present claimed invention was made). A small sampling of these U.S. patents is listed below for the Examiner's review.

6,026,905	5,771,974	4,436,157	4,375,239
4,320,804	4,116,272		

Additionally, as is typical in mechanical arts, the downhole art (as to its mechanical structures such as a subsea test tree) is unquestionably one of high predictability.

In summary, since (1) subsea test tree structures are notoriously well known in the art to which applicant's Claim 38 is directed, and (2) this art is highly predictable, under the clear standards set forth in MPEP §2164.03 the applicants' specification disclosure of the term "subsea test tree structure" together, coupled with their schematic drawing disclosure of such structure, unquestionably enables one skilled in this particular art to

make and/or use the invention, including the recited subsea test tree structure, without undue experimentation. The Examiner is thus respectfully requested to withdraw the 35 USC §112 first paragraph rejection of Claim 38.

Turning now to the 35 USC §102(b) anticipation rejections of Claims 1-5, 8, 9, 11, 17, 18, 22-24, 29-32, 35-37 and 44 over U.S. Patent 6,470,996 to Kyle et al, this reference discloses a method of **calibrating** an all-acoustic downhole signal transmission. During such calibration, a probe device is used to create the downward transmission through a downhole tubular structure of acoustic "sweep" signals which are subsequently picked up by the probe (which has been lowered through the tubular structure to receive the acoustic sweep signals) and transmitted to the surface, past what appears to be a hanger structure, in non-acoustic form. After the calibration process is completed, the signal transmission system is used in an **entirely acoustic** manner as it is designed for.

Via amended independent Claims 1 and 18, each of applicants' Claims 1-5, 8, 9, 11, 17, 18, 22-24, 29-32, 35-37 and 44 specifies that the system acoustically transmits a **noncalibrational** well parameter signal through the lower tubing structure, prior to converting the acoustically transmitted signal to a non-acoustic signal at a tubing structure location below the recited well structure (i.e., the hanger structure), and then transmitting the converted signal upwardly past the well structure along a signal path leading to a signal receiving location. It is important to note that when the Kyle et al system is used after its calibration, there is no disclosure that the downhole sensor-generated **acoustic** signal, as required by the present applicants' Claims 1-5, 8, 9, 11, 17, 18, 22-24, 29-32, 35-37 and 44, is converted downhole to a **non-acoustic** signal. The Kyle et

al system, during normal post-calibration operation thereof, is, after all, a wholly **acoustic** system.

For these reasons it is respectfully submitted that none of applicants' Claims 1-5, 8, 9, 11, 17, 18, 22-24, 29-32, 35-37 and 44 is anticipated by U.S. Patent 6,470,996 to Kyle et al.

Finally, with respect to the Examiner's obviousness rejections of various ones of applicants' dependent claims, it should first be noted that all of these dependent claims depend from either Claim 1 or Claim 18 and therefore contain the above-discussed limitations which Kyle et al fails to disclose or suggest. None of the secondary references being relied upon by the Examiner in any manner cures these clear deficiencies in Kyle et al.

For example, U.S. Patent 6,899,178 to Tubel has been cited by the Examiner solely for its alleged teachings with respect to converting an acoustic signal into an electromagnetic wave/photoelectrical signal. Accordingly, dependent Claims 6, 7, 12-16, 25-28, 33, 34 and 43 are seen to be patentably distinguishable over the Kyle et al/Tubel reference combination currently being proposed by the Examiner.

U.S. Patent 6,626,248 to Roberts et al has been cited by the Examiner solely for its alleged teachings with respect to a well structure in the form of a hanger structure. Accordingly, dependent Claims 10, 19-21, 41 and 42 are seen to be patentably distinguishable over the Kyle et al/Roberts et al reference combination currently being proposed by the Examiner.

Finally, U.S. Patent 4,314,365 to Petersen et al has been cited by the Examiner solely for its alleged teachings with respect to the provision with an electrohydraulic module to an acoustic signal transmission method. Accordingly, dependent Claims 39 and 40 are seen to be patentably distinguishable over the Kyle et al/Petersen et al reference combination currently being proposed by the Examiner.

In view of the foregoing amendment, remarks and arguments, all of the claims currently pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of Claims 1-44 is therefore earnestly solicited.

The Examiner is hereby requested to telephone the undersigned attorney of record at 972/516-0030 if such would further or expedite the prosecution of the instant application.

Respectfully submitted,

KONNEKER & SMITH, P.C.

A handwritten signature in black ink, appearing to read "J. Richard Konneker", written over a horizontal line.

J. Richard Konneker
Attorney for Applicants
Registration No. 28,867

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660 N. Central Expwy., #230
Plano, Texas 75074
972/516-0030

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450,

on January 12, 2006
Diane Sutton